

REMARKS**1.) Claim Amendments**

Applicants have amended claims 1, 5, 7, 14 and 18-20 to better claim the present invention; claims 4, 6, and 17 have been cancelled, without prejudice; and claim 24 has been added to further claim the present invention and its consideration by the Examiner is respectfully requested. Accordingly, claims 1-3, 5, 7-10, 12-16 and 18-24 are pending in the present patent application. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

2.) Claim Rejections – 35 U.S.C. §103

Claims 1-10 and 12-23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,389,008 issued to Lupien et al. (hereinafter "Lupien") in view of International Publication No. WO 99/11032 listing Peltola as an inventor (hereinafter "Peltola"). Before addressing this rejection in detail, it should be noted that the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. *MPEP 2142*. To establish *prima facie* case of obviousness, certain criteria must be met. First, the prior art reference or references when combined must teach or suggest all the claim limitations. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. With the above requirements in mind, Applicants respectfully traverse this rejection per discussion below.

Responsive to the Examiner's rejection of independent claim 1, Applicants have amended such claim by adding the limitation of "*notifying the mobile station to synchronize with a remaining carrier.*" Applicants respectfully submit that Lupien, Peltola or their combination fails to teach or suggest this newly added claim limitation. Regarding Lupien, it discusses a mobile station capable of accessing both circuit switched and packet data networks and having a default mode to access packet data or GPRS network. *Col. 15, lines 31-34*. Once the mobile station is registered with the

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GPRS network, the GPRS network automatically **synchronizes** the mobile station with the circuit switched network **without notifying** the mobile station of such synchronization. To do so, the SGSN 32 of the GPRS network informs the MSC/VLR 23 of the circuit switched network regarding the mobile station's registration with the GPRS network so that the HLR/AC 21 of the circuit switched network could be updated allowing the mobile station to later switch from packet data mode to circuit switched mode to receive an incoming circuit switched call. *Col. 15, lines 34-42 and Col. 16, lines 40-43.* In contrast, the present inventive method **notifies** the mobile station to synchronize with a remaining carrier and thereby the mobile station is synchronized to such remaining carrier. *See, e.g., Application, page 5, lines 7-15.* Lupien simply fails to teach or suggest this notification. Likewise, the same is true with Peltola. More specifically, the Examiner relies on Peltola for the disclosure of "synchronizing the mobile station to the default carrier." *See Office Action, page 3.* Even assuming *arguendo* that the Examiner's reliance is proper, such disclosure by Peltola has nothing to do with any notification. Thus, Peltola fails to teach or disclose all the limitations of claim 1.

Accordingly, claim 1 is believed to be non-obvious and patentably distinguishable over Lupien in view of Peltola.

Regarding claims 2-3, 5 and 7, they depend from claim 1, which is believed to be patentable, and thus such claims should also be non-obvious and patentably distinguishable over Lupien in view of Peltola. *MPEP 2143.03.*

Regarding claims 4 and 6, they are cancelled and thus their rejection no longer applies.

Regarding the rejection of claim 8, the section of Lupien cited by the Examiner discusses how an incoming circuit switched call could be received by a mobile station via the GPRS network **even though** such mobile station is also engaged in packet data call with the GPRS network. *Col. 16, lines 23-27.* Applicants respectfully submit that **the cited section has nothing to do with the present invention according to claim 8.** According to claim 8, a data call to a mobile station is connected over a best-efforts carrier. If a specified condition is detected while the data call is in progress, the mobile station is synchronized to an all-services carrier and thereby the data call is continued

over the all-services carrier. In other words, the active data call could be transferred from the best-efforts carrier to the all-services carrier if a certain specified condition is detected. In contrast, Lupien focuses on **how to receive** an incoming call, not **how to continue** an active call by transferring it from a first carrier to a second carrier if a specified condition is detected. That is, Lupien fails to teach or disclose all the limitations of claim 8. Likewise, the same is true with Peltola. More specifically, the Examiner relies on Peltola for the disclosure of "*synchronizing the mobile station to the all-service carrier.*" See *Office Action*, page 3. Even assuming *arguendo* that the Examiner's reliance is proper, such disclosure by Peltola has nothing to do with how to continue an active call by transferring it from a first carrier to a second carrier if a specified condition is detected. Thus, Peltola fails to teach or suggest all the limitations of claim 8.

Accordingly, claim 8 is believed to be non-obvious and patentably distinguishable over Lupien in view of Peltola.

Regarding claims 9-10 and 12-13, they depend from claim 8, which is believed to be patentable, and thus such claims should also be non-obvious and patentably distinguishable over Lupien in view of Peltola. *MPEP 2143.03*.

Regarding claim 14, it contains limitations that are similar to those of claim 1 and thus claim 14 is believed to be non-obvious and patentably distinguishable over Lupien in view of Peltola for reasons similar to those discussed above regarding claim 1.

Regarding claims 15-16 and 18-20, they depend from claim 14, which is believed to be patentable, and thus such claims should also be non-obvious and patentably distinguishable over Lupien in view of Peltola. *MPEP 2143.03*.

Regarding claim 17, it is cancelled and thus its rejection no longer applies.

Regarding claim 21, it contains limitations that are similar to those of claim 8 and thus claim 21 is believed to be non-obvious and patentably distinguishable over Lupien in view of Peltola for reasons similar to those discussed above regarding claim 8.

Regarding claims 22-23, they depend from claim 21, which is believed to be patentable, and thus such claims should also be non-obvious and patentably distinguishable over Lupien in view of Peltola. *MPEP 2143.03*.

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CONCLUSION

Claims 1-3, 5, 7-10, 12-16 and 18-24 are presently standing in this patent application. In view of the foregoing remarks, each and every point raised in the Office Action mailed on November 10, 2003 has been addressed on the basis of the above remarks. Applicants believe all of the claims currently pending in this patent application to be in a condition for allowance. Reconsideration and withdrawal of the rejections are respectfully requested. However, should the Examiner believe that direct contact with Applicants' attorney would advance the prosecution of the application, the Examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,



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